

REMARKS

In the Final Office Action¹, the Examiner rejected claims 1-15 under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 5,828,374 to Coleman et al. ("*Coleman*") in view of U.S. Patent No. 5,828,374 to Schirmer et al. ("*Schirmer*") and further in view of U.S. Patent No. 5,714,971 to Shalit et al. ("*Shalit*"). For the reasons set forth below, Applicants respectfully traverse the rejection.

M.P.E.P. § 2143.01(V) states that "[i]f [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)." Applicants respectfully traverse the rejection under 35 U.S.C. § 103(a), because the Examiner's proposed combination of *Coleman* with either *Schirmer* or *Shalit* would render *Coleman* unsatisfactory for *Coleman*'s intended purpose.

Independent claim 1 recites, for example, a computer program product comprising instructions operable to cause data processing apparatus to:

receive user input from a user to establish a normal mode or a decoupled mode of user interface operation; and
receive navigation input, distinct from the user input, to navigate from one user interface element to another user interface element, where in the normal mode, navigation to an independent element with the navigation input is sufficient to cause the independent element to become the selected element, and where in the decoupled mode, navigation to an

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

independent element does not change which, if any, of the independent elements is the selected element

(emphasis added).

Coleman discloses a help index that can be searched using an “alpha scroll bar” (*Coleman*, Fig. 8, and col. 10, line 51 to col. 11, line 14). Letters on the alpha scroll bar can be selected by a number of methods, including “placing [a] cursor over a portion of slider 175, depressing [mouse] switch 46 and dragging the cursor and slider over the desired letter ... [and] releas[ing] [mouse] switch 46,” (*Coleman*, col. 11, lines 20-23). When a letter in the alpha scroll bar is selected, help index entries beginning with the selected letter are displayed (*Coleman*, col. 11, lines 64-66).

The Examiner asserts that depressing the mouse switch in *Coleman* establishes a mode corresponding to the claimed “decoupled mode,” dragging the cursor and slider after pressing the mouse switch to identify a letter corresponds to the claimed “navigation input,” and releasing the mouse switch establishes a mode corresponding to the claimed “normal mode” (Office Action at p. 3). Thus, assuming the Examiner is correct, which Applicants specifically do not concede, *Coleman* discloses a sequence of: (1) establishing the decoupled mode by pressing the mouse switch; (2) navigating to an identified letter by dragging the cursor and slider over the letter; and (3) releasing the mouse switch to establish the normal mode and thus select the identified letter.

Schirmer discloses a method for managing and presenting information for a group of data objects which can be associated with other data objects (*Schirmer*, abstract). A user can select a data object, and be presented with a number of other

data objects that are related to the selected data object (*Schirmer*, col. 6, lines 60-64, and Fig. 1). A user can also filter the related objects based on criteria such as secondary objects (*Schirmer*, col. 14, line 57 to col. 15, line 42).

The Examiner contends that *Schirmer's* disclosure of selecting objects corresponds to the claimed "navigation to an independent element with the navigation input is sufficient to cause the independent element to become the selected element" (Office Action at p. 4). However, to select a data object in *Schirmer*, the user must first navigate to, and then click on an object (*Schirmer*, col. 14, lines 27-30), and one skilled in the art would understand that this means both depressing and releasing the mouse switch.

Thus, in order to select an object in *Schirmer*, a user must: (1) navigate to the identified object with the cursor; (2) click the mouse switch; and (3) release the mouse switch. Note that the first step in *Schirmer* would occur with the mouse switch released. Thus, assuming *Schirmer* were combined with *Coleman*, simply moving the cursor over any object such as a letter would cause that letter to become the selected letter. This would frustrate *Coleman's* purpose of allowing a user to depress the mouse switch, identify a letter, and then only select the letter once the mouse switch is released, because in the proposed combination the letter would become selected before the mouse switch is released.

The combination of *Coleman* and *Shalit* is improper for the same reasons as those discussed with respect to *Coleman* and *Schirmer*. *Shalit* discloses dragging an object to a "split bar box" which causes a second "pane" to open in a window (*Shalit*,

col. 5, lines 5-10). The second pane displays the contents of the dragged object (*Shalit*, col. 5, lines 19-21). The Examiner contends that *Shalit*'s disclosure of dragging objects to a split bar box corresponds to the claimed "navigation input[]" distinct from the user input" (Office Action at p. 4).

However, one skilled in the art would understand that to drag the object in *Shalit*, one must: (1) navigate to the object; (2) depress the mouse switch; (3) navigate with the cursor to the split bar box; and (4) release the mouse switch. Like *Schirmer*, the first step in *Shalit* would occur with the mouse switch released, again frustrating *Coleman*'s purpose of allowing a user to depress the mouse switch, identify a letter, and then only select the letter once the mouse switch is released.

Because the proposed combination of *Coleman* with either *Schirmer* or *Shalit* would render *Coleman* unsatisfactory for *Coleman*'s intended purpose, the Examiner has not established a suggestion or motivation to make the proposed modification. Therefore, no *prima facie* case of obviousness has been established with respect to independent claim 1.

Although of different scope, independent claims 8 and 15 recite features similar to those of claim 1 already discussed. Claims 1-7 depend from claim 1, and claims 9-14 depend from claim 8. Therefore, Applicants request that the rejection of the pending claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

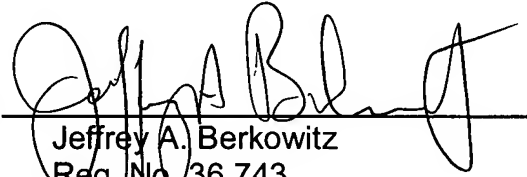
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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